

## **REMARKS**

### **I.      Introductory Comments**

Applicants have carefully reviewed the Final Office Action mailed January 31, 2008, and thank the Examiner for the detailed review of the pending claims. No amendments have been made to the claims in this paper. Therefore, claims 1-14, 16, 18-24, and 26-30 remain pending in the application. Claims 1, 8, and 22 are independent claims. All of the pending claims were rejected by the Examiner using a combination of no less than four references.

In the Final Office Action, the Examiner rejected: (1) claims 1-5, 8-12, 14, 21-24, 26, 27, and 30 under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent No. 6,222,909 (hereinafter “Qua”), U.S. Patent No. 6,529,602 (hereinafter “Walker”), U.S. Patent No. 5,995,824 (hereinafter “Whitfield”), and U.S. Patent No. 5,524,137 (hereinafter “Rhee”); (2) claims 6 and 13 under 35 U.S.C. §103(a) as being unpatentable over the combination of Qua, Walker, Whitfield, Rhee, and U.S. Patent No. 6,230,214 (hereinafter “Liukkonen”); (3) claim 16 under 35 U.S.C. §103(a) as being unpatentable over the combination of Qua, Walker, Whitfield, Rhee, and U.S. Patent Application Publication No. 2002/0023099 (hereinafter “Wendelrup”); and (4) claims 7, 14, 18-20, 28, and 29 under 35 U.S.C. §103(a) as being unpatentable over the combination of Qua, Walker, Whitfield, Rhee, Wendelrup, and U.S. Patent No. 6,278,772 (hereinafter “Bowater”).

In view of the following arguments, all claims are believed to be in condition for allowance. Therefore, this response is believed to be a complete response to the Final Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.<sup>1</sup> Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of

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1. As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

## **II. Premature Final Office Action**

This Final Office Action cannot be made final because the Examiner has introduced several new grounds of rejection that were not necessitated by a claim amendment in the Applicants' previous response. In addition, the Examiner's new grounds of rejection rely on at least one newly cited reference. Therefore, Applicants respectfully request the Examiner to withdraw the finality of this Final Office Action.

In the previous Office Action, dated October 18, 2007, the Examiner rejected every claim using official notice in combination with one or more references. Applicants responded by arguing that the use official notice was improper, and the Examiner withdrew the Official Notice. The only amendment in the previous response corrected a minor typographical error in dependent claim 19, with no change in the intended claim scope or meaning. The Examiner has now issued new grounds of rejection to reject every pending claim. These new rejections were not necessitated by any claim amendment. The Examiner has also admitted that these rejections are new, by stating that "Applicant's arguments . . . are deemed to be moot in view of the new grounds of rejection." Final Office Action, page 17, emphasis added. The Examiner also issued new grounds of rejection based on at least one newly cited reference, namely Bowater (U.S. Patent No. 6,278,772). Final Office Action, page 14. Bowater has not been previously cited by the Examiner in at least any of the previous 11 office actions. According to the MPEP, an office action cannot be made final if it includes new grounds of rejection that were not necessitated by an amendment. Furthermore, the MPEP states that an office action cannot be made final if a new ground of rejection includes newly cited art.

According to MPEP §706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement." "Furthermore, a second or any subsequent action on the merits . . . will not be made final if it includes a rejection, on newly cited art, other than information submitted

in an information disclosure statement.” (MPEP §706.07(a), emphasis added.) Applicants did not make any substantive claim amendments, nor did Applicants file an information disclosure statement in response to the previous office action. Applicants therefore respectfully request the Examiner to withdraw the finality of this Final Office Action.

### **III. Claims 1, 2, 4, 5, 8-12, 14, 21-24, 27, and 30 are Patentable Over the Combination Of Qua, Walker, Whitfield, and Rhee**

#### **A. Independent Claim 1**

The Examiner alleged that independent claim 1 is unpatentable over the combination of four references, namely Qua, Walker, Whitfield, and Rhee. However, claim 1 is patentable over the cited references for at least the following reasons, as discussed in detail below.

#### **1. The Relied Upon References Fail to Teach or Suggest “a user interface configured to allow a user of the wireless communication device to . . . [edit] . . . two-way conversation data stored in the remote storage device”**

The Examiner admits that Qua fails to disclose numerous recitations of claim 1. For example, the Examiner stated that “Qua does not explicitly say that the plurality of data management functions includes functions for editing the two-way conversation data stored in the remote storage device.” Final Office Action, page 3. The Examiner then alleged that “Walker covers this feature (see column 5).” Final Office Action, page 3. However, Walker makes no mention of a “a wireless communication device,” nor does Walker mention “a user interface configured to allow a user of the wireless communication device to access, by way of a wireless network, the two-way conversation data stored in the remote storage device.” Walker makes no mention of “a wireless network” at all. Notably, Walker fails to teach or suggest that “the user interface [includes] a plurality of data management functions,” where “the plurality of data management functions [includes] functions for editing . . . the two-way conversation data stored in the remote storage device,” as positively recited in claim 1.

Walker is directed to “a method and apparatus for recording audio information in an authenticatable, tamper-proof manner.” Walker: col. 1, lines 6-8. Walker not only fails to mention “a wireless network,” as positively recited in independent claim 1, but specifies that the “first-described embodiment is used to record a conversation between two parties . . . via a pair

of conventional telephone connections.” Walker: col. 4, lines 39-41. Walker further discloses that “[i]n an alternative embodiment, in lieu of sending the audio information over ordinary telephone lines, the participating party can access the information via computer network connections or the Internet.” Walker: col. 4, line 65 – col. 5, line 1.

At most, Walker suggests “a second playback mode in which modification of the recorded information can be affected.” Walker: col. 5, lines 5-6. However, Walker specifically states that “the audio vault can not modify a recording without authorization from all of the parties to the recording.” Walker: col. 5, lines 13-15. Further, Walker discloses that “authorization from both of the parties to the conversation must be received before the audio vault can modify stored information.” Walker: col. 5, lines 7-9. Thus, Walker fails to teach or suggest “a user interface configured to allow a user of the wireless communication device to . . . [edit] . . . two-way conversation data stored in the remote storage device,” as positively recited in independent claim 1.

## **2. Walker Teaches Away From Editing Two-Way Conversation Data**

As clearly stated in MPEP §2145(X)(D)(2), “[i]t is improper to combine references where the references teach away from their combination.” *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). In performing a 35 U.S.C. §103 analysis, it is error to consider “references in less than their entirety, i.e. in disregarding disclosures in the references that diverge from and teach away from the invention at hand.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Walker is directed to a method and apparatus for recording a conversation in a secure manner that prevents editing. Walker discusses at length the need to safeguard audio recordings to prevent tampering and ensure accurate reproductions. Walker: Background section. Walker specifically discloses that a shortcoming of “[e]xisting methods of recording conversations,” such as by using “telephone answering machines, tape recorders, and handheld digital audio recording devices,” is that it is “relatively easy to delete or to alter the recorded audio information.” Walker: col. 1, lines 36-41, emphasis added. In discussing the STEN-TEL system, which is disclosed as “a system designed specifically for recording telephonic audio

information,” Walker notes that one drawback of the STEN-TEL system is that “information is vulnerable to tampering.” Walker: col. 1, lines 65-66, and col. 2, lines 13-24. As stated in *Akzo N.V. v. United States Int’l Trade Comm’n*, 1 USPQ 2d 1241 (Fed. Cir. 1986), prior art references must be read as a whole. Reading Walker as a whole, it is apparent that Walker teaches away from “[allowing] a user of the wireless communication device to . . . [edit] . . . two-way conversation data stored in the remote storage device,” as positively recited in independent claim 1.

### **3. Walker Cannot Be Combined with Qua**

The Examiner alleged that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Qua with the edit feature of Walker.” Final Office Action, page 3. Further, the Examiner alleged that “[t]his modification would have improved the system’s flexibility by allowing the user to perform other intermediate processing/distribution functions as suggested by Qua (see column 6).” Final Office Action, pages 3-4. However, the combination of Qua and Walker would have the opposite effect, and would inhibit or prevent numerous aspects of both systems from functioning. Thus, not only is there no motivation to combine Qua with Walker, but Qua and Walker are incapable of combination.

Qua is directed to an “audio note taking system and method that permit[s] a user to record audio information . . . and distribute the information to other users in an efficient and accurate manner by working with other types of communication and information devices, such as voice mail and electronic mail servers.” Qua: Abstract. Qua discloses that “each party [to a conversation] can record private comments,” and that the “recorded message may be distributed to other parties as an audio or text file utilizing electronic mail and voice mail servers.” Qua: Abstract, emphasis added. Further, Qua’s system “permit[s] recording, distributing and retrieving of audio messages in a hands free manner.” Qua: Abstract. In addition, the system disclosed by Qua “includes a detachable storage unit for recording the information and transferring the recorded information to another storage medium.” Qua: Abstract.

Walker, on the other hand, discloses a “system that can record audio conversations in a secure manner.” Walker: col. 2, lines 44-46. “The system can be implemented as a central server . . . or a stand-alone unit.” Walker: Abstract. “The system operates by encrypting audio

information, storing the encrypted information, and providing users with a cryptographic key that can be used to decrypt the stored information.” Walker: Abstract. Further, Walker specifies that “[a]fter the connections are established between the audio vault 12 and both parties, the audio vault conferences the two calls together . . . [but] [a]t this point, nothing is being recorded without the consent of all parties to the conversation.” Walker: col. 6, lines 44-49. As discussed above, Walker discloses a system that attempts to limit access to the stored conversation data, includes multiple levels of security and access restrictions, and is concerned with “recording audio information in an authenticatable, tamper-proof manner.” Walker: col. 1, lines 6-8.

The systems described by Qua and Walker are incompatible and incapable of combination for at least the following reasons. First, Qua specifically discloses a system that distributes audio notes to other users “in an efficient and accurate manner by working with other types of communication and information devices.” Qua: Abstract. Unlike Qua, Walker’s system is either a centralized system or a stand-alone device that maintains the recordings in an isolated system and does not transfer stored information to other devices or systems. Further, requiring a centralized or stand-alone system to be imposed, hypothetically, on Qua would cripple the system described by Qua and prevent the system from distributing audio notes to other systems. In addition, the system of Qua has no need to encrypt or authenticate audio notes, as the purpose is to distribute audio notes in an efficient manner. Encrypting the audio notes of Qua would inhibit users from distributing audio notes to others. Lastly, requiring a cryptographic key to access a recording would prevent Qua’s system from “recording, distributing and retrieving of audio messages in a hands free manner,” as a user must provide a cryptographic key. Qua: Abstract. Thus, for at least the foregoing reasons, Qua and Walker are incapable of combination.

#### **4. The Examiner’s Reliance on Whitfield is Irrelevant**

Independent claim 1 recites in part “a memory coupled to the wireless communication device for storing two-way conversation data in digital form.” The Examiner ignored this recitation and stated that “Qua and Walker fails [sic] to teach the two-way conversation data is stored as audio in the voice mail system.” Final Office Action, page 4, emphasis added. The Examiner then continued to allege that “Whitfield discloses this limitation (see column 3).” Final Office Action, page 4. However, claim 1 positively recites that the “two-way conversation

data” is stored “in digital form.” Thus, the Examiner’s statement that Qua and Walker fail to teach data stored as audio, and the Examiner’s subsequent reliance on Whitfield to teach audio, are both irrelevant. Further, the Examiner failed to make a prima facie case of obviousness in the first place by ignoring this recitation of claim 1. For at least the foregoing reasons, independent claim 1, and claims 2-7 that depend from claim 1, are in condition for allowance, and Applicants respectfully request the Examiner to withdraw the rejection of independent claim 1.

### **5. Rhee Cannot Be Combined with Qua**

The Examiner admitted that “nowhere does the combination of Qua, Walker and Whitfield teach [that] the plurality of data management functions includes translating the audio,” but alleged that “Rhee discloses this feature (see column 3).” Final Office Action, page 4. The Examiner then stated that “it would have been obvious . . . to further modify the combination of Qua, Walker and Whitfield wherein [sic] the plurality of data management functions includes translating the audio as shown by Rhee.” Final Office Action, page 5. The Examiner then alleged that “[t]his modification would have improved the system’s flexibility by allowing the user to perform other intermediate processing/distribution functions as suggested by Qua (see column 6).” Final Office Action, page 5. However, Rhee and Qua are incapable of combination at least because Rhee, like Walker, requires a user to record a message on a centralized message service, while Qua discloses a system that permits a user to record audio notes on a wired or a wireless communication device. In addition, Rhee is directed to a message service, as opposed to “a wireless communication device for storing two-way conversation data,” as positively recited in independent claim 1.

For at least the foregoing reasons, independent claim 1 is patentable from the cited references. Thus, Applicants respectfully request the Examiner to withdraw the rejection of independent claim 1.

**B. Claims Dependent on Claim 1**

Claims 2 through 5 are patentable since they depend from claim 1, the patentability of which has been discussed above. However, the dependent claims are separately patentable. Merely by way of example, discussions of specific dependent claims follow:

1. Dependent Claim 4

Dependent claim 4 recites the “apparatus of claim 1, further comprising a secondary device interface that couples the memory with a secondary device to allow transfer of the two-way conversation data from the memory to the secondary device.” The Examiner alleged that Qua discloses this recitation by stating “[r]egarding claim 4, see column 3 of Qua.” Final Office Action, page 5. However, Qua fails to teach or suggest “a secondary device interface that couples the memory with a secondary device to allow transfer of the two-way conversation data from the memory to the secondary device,” as positively recited in claim 4.

At most, Qua discloses that “the user may record and store audio notes on a detachable storage unit 120.” Qua: col. 3, lines 41-42. Further, Qua discloses that “[i]f the audio note is stored on detachable storage unit 120, the user then has the ability to upload this information to a personal computer or other such compatible device.” Qua: col. 3, lines 52-55. However, Qua fails to disclose “a wireless communication device . . . further comprising a secondary device interface that couples the memory with a secondary device,” as positively recited in dependent claim 4. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 4.

2. Dependent Claim 5

Claim 5 depends from claim 4 and recites in part that “the secondary device interface includes an attachment that physically connects the memory to the secondary device.” Regarding claim 5, the Examiner alleged that Qua teaches this recitation in column 7. Final Office Action, page 5. However, Qua fails to teach or suggest a “secondary device interface [that] includes an attachment that physically connects the memory to the secondary device.” At most, Qua discloses that “communications device 400 further includes an optional detachable



storage unit 450 for recording and playing back the user's audio notes." Qua: col. 7, lines 20-22. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 5.

### **C. Independent Claim 8**

The Examiner again admitted that "Qua does not explicitly say that the plurality of data management functions includes functions for editing the two-way conversation data stored in the remote storage device." Final Office Action, page 7. The Examiner then alleged that "Walker covers this feature (see column 5)." Final Office Action, page 7. As discussed above with respect to claim 1, Walker fails to teach or suggest "a user interface that allows a user of the wireless communication device to . . . [edit] . . . two-way conversation data stored in the storage location," as positively recited in claim 8. Furthermore, Walker expressly teaches away from editing stored two-way conversation data, as discussed above. In addition, as detailed above, Walker and Qua are incapable of combination. Further, as discussed above, Qua and Rhee are also incapable of combination. The Examiner also failed to make a prima facie case of obviousness by ignoring that claim 8 positively recites that the "two-way conversation data [is stored] in digital form."

For at least the foregoing reasons, independent claim 8 is patentable from the cited references. Thus, Applicants respectfully request the Examiner to withdraw the rejection of independent claim 8.

### **D. Claims Dependent on Claim 8**

Claims 9 through 21 are patentable since they depend from claim 8, the patentability of which has been discussed above. However, the dependent claims are separately patentable. Merely by way of example, discussions of specific dependent claims follow:

#### **1. Dependent Claim 11**

Claim 11 depends from claim 8 and recites "[t]he system of claim 8, further comprising a secondary device interface that couples the memory with a secondary device having the storage location to allow transfer of the two-way conversation data from the memory to the secondary device." Regarding claim 11, the Examiner alleged that Qua teaches this recitation in column 7. Final Office Action, page 8. However, Qua fails to teach or suggest this recitation. At most,

Qua discloses that “communications device 400 further includes an optional detachable storage unit 450 for recording and playing back the user’s audio notes.” Qua: col. 7, lines 20-22. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 11.

2. Dependent Claim 12

Claim 12 depends from claim 11 and recites in part that “the secondary device interface includes an attachment that physically connects the memory to the secondary device.”

Regarding claim 12, the Examiner alleged that Qua teaches this recitation in column 7. Final Office Action, page 8. However, as discussed above in reference to claim 5, Qua fails to teach or suggest this recitation. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 12.

**E. Claims 22-24 and 26-30**

The Examiner rejected independent claim 22 by combining four references, namely Qua, Walker, Whitfield, and Rhee. As discussed above with respect to claim 1, Walker fails to teach or suggest “a user interface . . . that allows a user of said at least one wireless communication device to . . . [edit] . . . said data stored in said at least one storage location,” as positively recited in independent claim 22. Furthermore, Walker expressly teaches away from editing such data, as discussed above with respect to claim 1. In addition, as detailed above, Walker and Qua are incapable of combination. Further, as discussed above, Qua and Rhee are also incapable of combination. For at least the foregoing reasons, independent claim 22, and claims 23-24, and 26-30 that depend from claim 22, are in condition for allowance, and Applicants respectfully request the Examiner to withdraw the rejection of independent claim 22.

**IV. Claims 6 and 13 are Patentable Over the Combination Of Qua, Walker, Whitfield, Rhee, and Liukkonen**

**A. Dependent Claim 13**

Claim 13 depends from claim 11 and recites in part that “the secondary device interface includes an attachment that physically connects the memory to the secondary device.”

Regarding claim 12, the Examiner alleged that Qua teaches this recitation in column 7. Final Office Action, page 8. However, as discussed above in reference to claim 5, Qua fails to teach or

suggest this recitation. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 13

**V. Claims 7, 14, 18-20, 26, 28, and 29 are Patentable Over the Combination Of Qua, Walker, Whitfield, Rhee, Wendelrup, and Bowater**

**A. Dependent Claim 7**

Claim 7 depends from claim 1 and recites in part that “the plurality of data management functions includes functions for searching, linking, downloading, editing, playing back, converting, sending, archiving, and deleting the two-way conversation data stored in the storage location.” The Examiner admitted that “Qua does not explicitly teach [that] the plurality of data management functions includes functions for editing and deleting the two-way conversation data.” Final Office Action, page 14. The Examiner then alleged that “Walker covers this feature (see column 5).” Final Office Action, page 14. As discussed above with respect to claim 1, Walker fails to teach or suggest that “the plurality of data management functions includes functions for . . . editing . . . the two-way conversation data,” as positively recited in claim 7. Furthermore, Walker expressly teaches away from editing such data, as discussed above with respect to claim 1. In addition, as detailed above, Walker and Qua are incapable of combination.

The Examiner also admitted that “the combination of Qua and Walker does not clearly mention the plurality of data management functions includes a function for archiving the two-way conversation data stored in the storage location.” Final Office Action, page 15. The Examiner then alleged that “Whitfield shows this limitation (see column 4).” Final Office Action, page 15. However, Whitfield says nothing at all about archiving. At most, Whitfield discloses a “voice recording embodiment” where “the subscriber can retrieve the recorded information using the same procedure as that required for accessing voice mail.” Whitfield: col. 4, lines 46-48. Further, Whitfield discloses that the system “allows the subscriber to listen to messages . . . save messages, and other similar options depending upon the voice mail system.” Whitfield: col. 4, lines 51-54. However, Whitfield fails to teach or suggest that “the plurality of data management functions includes functions for . . . archiving . . . two-way conversation data,” as positively disclosed in claim 7. Thus, for at least the foregoing reasons, Applicants respectfully request the Examiner to withdraw the rejection of claim 7.

### **B. Dependent Claim 14**

Claim 14 depends from claim 8 and recites in part that “the plurality of data management functions includes functions for searching, linking, downloading, editing, playing back, converting, sending, archiving, and deleting the two-way conversation data stored in the storage location.” The Examiner rejected claim 14 “for the same reasons as for claim 7.” Final Office Action, page 16. However, as discussed above in reference to claim 7, the cited references fail to teach or suggest this recitation. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 14.

### **C. Dependent Claims 26**

Claim 26 depends from claim 22 and recites in part that the “plurality of data management functions includes functions for searching, linking, downloading, editing, playing back, converting, sending, archiving, and deleting said data stored in the storage location.” The Examiner rejected claim 26 “for the same reasons as claim 14.” Final Office Action, page 12. However, as discussed above in reference to claim 7, the cited references fail to teach or suggest this recitation. Thus, Applicants respectfully request the Examiner to withdraw the rejection of claim 26.

### **CONCLUSION**

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested, and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0041. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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